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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,506	03/29/2000	Judith Continelli	10655.9400	6236

7590   07/05/2005

Snell & Wilmer L L P
One Arizona Center
400 East Van Buren
Phoenix, AZ 85004-2202

EXAMINER
BACKER, FIRMIN

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO 90C (Rev 10/03)

	Application No.	Applicant(s)
	09/537,506	CONTINELLI ET AL.
Office Action Summary	Examiner	Art Unit
	Firmin Backer	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 April 2005* .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *47-55* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *47-55* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☒ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: . .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.   Claims 49 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

3.   Claim 49 recites the limitation "the second presentment" in line 1. There is insufficient

antecedent basis for this limitation in the claim. A first presentment is not previously disclosed

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 47-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Israel et al (U.S

PG Pub no. 2004/0210540).

6.   As per claim 47, Isreal et al teach a method, implemented on a computer network, for

facilitating the manual input of information into a plurality of electronic documents selected

from a discrete set of electronic templates, for the purpose of streamlining the resolution of a

financial dispute relating to a transaction card transaction, the method comprising the steps of:

performing a purchase transaction between a cardmember and a merchant using a transaction

card issued to the cardmember by an Issuer, thereafter providing notice by the cardmember to the

Issuer that the cardmember disputes the purchase transaction; the Issuer initiating, in response to

the notice from the cardmember, a predetermined resolution protocol, wherein the purpose of the

protocol is to resolve an ensuing dispute between the Issuer and an Acquirer with respect to a

backend processing transaction associated with the purchase transaction, and further wherein the

backend transaction involves the Acquirer collecting money from the cardmember and

coordinating payment to the merchant for the purchase transaction in accordance with a

preexisting backend processing agreement between the Issuer and the Acquirer', wherein the

resolution protocol comprises selecting, by the Issuer, from a discrete, predetermined set of

electronic dispute resolution templates, a first template', manually inputting into the first

template, by the Issuer, information relating to the disputed purchase transaction to thereby

generate from the first template a first issuer form; electronically transmitting the first issuer

form from the Issuer to the Acquirer; successively selecting additional ones of the templates, by

the Issuer and the Acquirer, respectively, to thereby generate additional issuer and Acquirer

forms; and electronically exchanging the additional issuer and acquirer forms in accordance with

the resolution protocol, and resolving the backend transaction dispute between the issuer and the

Acquirer using the issuer forms and the Acquirer form; and in accordance with the resolution

protocol (*see paragraphs 0009, 0011, 0014, 0016, 00356, 0053, 0060, 0132, 0134-0138, 0144, 0145, 0150, 0151*).

7.   As per claim 48, Isreal et al teach a method of retrieving at least one stored file; and attaching the file to the one of at least one of the Issuer forms and Acquirer forms (*see paragraphs 0009, 0011, 0014, 0016, 00356, 0053, 0060, 0132, 0134-0138, 0144, 0145, 0150, 0151*)..

8.   As per claim 49, Isreal et al teach a method comprises at least one of Retrieval Request, a First Chargeback and a Final Chargeback, and the Acquirer forms comprises at least one of a Fulfillment and a Second Presentment (*see paragraphs 0009, 0011, 0014, 0016, 00356, 0053, 0060, 0132, 0134-0138, 0144, 0145, 0150, 0151*)..

9.   As per claim 50, Isreal et al teach a method comprising selecting, by the Acquirer, a second template from the predetermined set, and manually inputting into the second template information responsive to the first issuer form to thereby generate a first acquirer form; and, electronically transmitting the first acquirer form from the Acquirer to the Issuer (*see paragraphs 0009, 0011, 0014, 0016, 00356, 0053, 0060, 0132, 0134-0138, 0144, 0145, 0150, 0151*)..

10.   As per claim 51, Isreal et al teach a method executed in a network computer system for facilitating communication between an Issuer and an Acquirer in the context of resolving a post-transactional dispute, wherein the dispute is between the Issuer and the Acquirer and the dispute is related to an executed credit transaction between a cardmember and a merchant, the executed

credit transaction involving a cardmember's transaction card, the network computer system

having a server and at least one access terminal, the method comprising accepting at the server a

User ID and password from the Issuer at a first access terminal, retrieving from the server a pre-

defined set of Issuer dispute handling forms having pre-defined content which coincide with the

User ID; displaying the pre-defined set of Issuer forms at the first access terminal, selecting, by

the Issuer, one of the pre-defined set of Issuer forms at the first access terminal; receiving input

entered on the selected one of the Issuer forms at the first access terminal', transmitting within

the network the one of the Issuer forms to the Acquirer in dispute with the Issuer', notifying the

Acquirer at a second access terminal of the one of the Issuer forms; accepting at the server a User

ID and password from the Acquirer at the second access terminal', retrieving from the server a

set of Acquirer dispute handling forms having pre- defined 'content which coincide with the

Acquirer User ID; displaying the set of Acquirer forms at the second access terminal; selecting,

by the Acquirer, one of the Acquirer forms at the second access receiving input entered on the

selected one of the Acquirer forms at the second access terminal; transmitting within the network

the one of the Acquirer forms to the Issuer; and, notifying the Issuer at the first access terminal

of the one of the Acquirer forms (*see paragraphs 0009, 0011, 0014, 0016, 00356, 0053, 0060,*

0132, 0134-0138, 0144, 0145, 0150, 0151)..

11.   As per claim 52, Isreal et al teach a method of retrieving at least one stored file from the

server; and attaching the file to the one of at least the Issuer forms and Acquirer forms (*see*

paragraphs 0009, 0011, 0014, 0016, 00356, 0053, 0060, 0132, 0134-0138, 0144, 0145, 0150,

0151)..

12.   As per claim 53, Isreal et al teach a method of receiving at the second access terminal at

least one scanned document computer readable format storing the scanned document on the

server; and attaching the scanned document to one of the forms (*see paragraphs 0009, 0011,*

0014, 0016, 00356, 0053, 0060, 0132, 0134-0138, 0144, 0145, 0150, 0151).

13.   As per claim 54, Isreal et al teach a method of accepting at the server a User ID and

password from a third-party user at a third access terminal, retrieving from the server a set of

reports which coincide with the third-party user ID displaying the set of reports at the third

access terminal, and receiving instructions from the third party user to transfer monetary liability

to at least one of the Issuer from the Acquirer and the Acquirer from the Issuer (*see paragraphs*

0009, 0011, 0014, 0016, 00356, 0053, 0060, 0132, 0134-0138, 0144, 0145, 0150, 0151)..

14.   As per claim 55, Isreal et al teach a method comprises matching the User ID and

password with information stored in a database accessible to the server (*see paragraphs 0009,*

0011, 0014, 0016, 00356, 0053, 0060, 0132, 0134-0138, 0144, 0145, 0150, 0151).

Response to Arguments

15.   Applicant's arguments filed April 14th, 2005 have been fully considered but they are not

persuasive.

        a.   Applicant argues that the prior art fail to teach every element in the disclose

        inventive concept. Applicant further argues that each and every element of independent

        claim 47 and 51 are not taught in the prior art. Especially the concept of prompting a user

to enter a dispute resolution, selected by the user predefined dispute resolution form, issuer in response to a notice from a cardmember, initiate a predetermined protocol in to resolve an ensuring dispute between the issuer and the acquirer, retrieving from the server a predefined set of issuer handling forms having predefined set of issuer dispute handling form having predefined content which coincide with the user ID .. Examiner respectfully disagrees with Applicant's characterization of the prior art. Israel teach that the dispute party inputs data corresponding to a non-judicial dispute resolution, the system sorts, organizes and compiles the data, and enables the party to avail itself of a full range of non-judicial dispute resolution procedures. The system also allows users of the system to organize data corresponding to multiple disputes, manage that *data into a form selected by the user*, and generate reports based on the data from one or more disputes that have been input into the system to which they are a party. The present system allows parties to disputes to effectively and efficiently input, sort, organize and manage the data corresponding to disputes, and resolve disputes via the internet. Israel further teaches that before any Program User may begin to enter disputes into the system, they must be given access to the system by the Program Manager. The Program Manager clicks on the "Add User" icon on the Program Manager Page to access the Add User Form. The Add User Form prompts the Program Manager for the input of relevant Program User information such as name of the user, department, telephone number, e-mail address, etc. After a Program User selects to add a dispute, they are then prompted to select a profile classification 58 as either a plaintiff or a defendant. After selecting the appropriate profile, the user is then prompted to select from a displayed general list the nature of the dispute. *The general nature of the dispute can be a general dispute, a bad loan, a*

business transaction, construction, contract, credit card, foreclosure, labor and

employment, landlord/tenant, lender liability, partnership agreement, personal injury,

professional liability, purchase and sale transaction, rental agreement, intellectual

property, subrogation, worker compensation, or any other cause of action recognized by

a judicial system, whether in the United States or abroad. Once the opposing party

receives notification that a dispute has been entered into the system, they can respond to

the submitted dispute in several ways. Before responding, however, the opposing party

must have their access code and dispute code. Without these, the opposing party cannot

access the system. The opposing party, with access and dispute code in hand, uses the

web browser of their computer to locate and retrieve the web site for the present system

as described above. After accessing the web site, the responding party is prompted to

either utilize the settle-only access (if not already a Program Manager/User of the present

system), register a new account with the system and establish themselves as a Program

Manager/User, or indicate that they are not interested in utilizing the present system to

conduct negotiations of any kind. Further, the responding party (whether plaintiff or

defendant) may not agree to utilize the present system to resolve the dispute. If the

responding party so desires, they may click on the "Not Interested" icon. If the

responding party is not interested, the present system will notify the submitting party via

e-mail that the responding party is not interested in negotiating via the system.

b.   As for claims 47-55, they are not in compliance with 35 U.S.C 112 and are not

allowable over the art of record. Furthermore, as indicated, Israel teaches every element

in the disclosed inventive concept. Therefore the rejection is maintained and the action is

made final.

Conclusion

16.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time
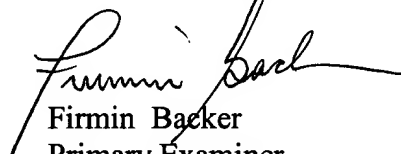
policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Firmin Backer whose telephone number is (571) 272-6703. The

examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Firmin Backer
Primary Examiner
Art Unit 3621

June 27, 2005